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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,166	07/08/2000	Holger Kunstle	U-Wp-5528 Wacker	8687

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EXAMINER
GALLAGHER, JOHN J

ART UNIT	PAPER NUMBER
1733	9

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-9

Office Action Summary	Application No. 09/6.2166	Applicant(s)	
	Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on th cover sheet beneath the correspondence address—

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☑ Responsive to communication(s) filed on 13 MARCH 2002.

☑ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1 - 17 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1 - 17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)-(d)

☑ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☑ All ☐ Some* ☐ None of the:

☑ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Atta hment(s)

☐ Information Disclosure Stat ment(s), PTO-1449, Paper No(s). _____

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Revi w, PTO-948

☐ Int rvi w Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

1. Claim 12 as presented is seen to be improper i.e. since this is a NEW claim, NO brackets or underlining should be present therein.

2. Claims 1-11 and 13-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically (a) claim 10 line 2 - need a period at the end of this line; further along this line, see paragraph 1(b) of the last Office action and note that claim 2 was mistakenly amended in this regard instead; and (b) the "wherein" clause at the end of each of independent claims 1 and 13 is seen to be inconsistent with the presence of component (e) in each of these claims (and also in claim 5), consistent with page 4 lines 21-27 of applicants' specification.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-16 are rejected under 35 U.S.C. § 102(b) as being (clearly) anticipated by Weissgerber et al. (newly applied).

Weissgerber et al. disclose ethylene-vinyl ester-carboxylic acid terpolymers which find utility as aqueous adhesives, which terpolymers (a) contain free carboxyl groups (i.e. are NOT neutralized); (b) need NOT contain any (meth)acrylate alkyl ester moieties; and (c) are composed of at least one vinyl ester i.e. provision is made for the use of a mixed vinyl ester (e.g. vinyl acetate and a vinyl versatate of e.g. 10 carbon atoms) component. (Abstract, column 1 line 39 thru column 3 line 43). All of the essential limitations of these claims are held to be satisfied by this reference, with the following being additionally advanced: (a) regarding process claims 8-10, N.B. column 1 lines 18-20 and column 7 lines 16-21 of the Wiest et al. reference (which is held to constitute an integral and explicit part of the Weissgerber et al. teaching, being clearly and fairly incorporated and referred to therein viz. N.B. column 3 lines 41-43 thereof); and (b) although it is realized that the issue and basis of the foregoing art rejection is anticipation and not obviousness, it is noted that while the problem ~~for the~~ confronting an inventor is A factor which must be considered in determining the obviousness of the claimed invention, the absence of an explicit appreciation of a particular problem in the prior art is not dispositive of the issue of obviousness, but is ONLY ONE of the MANY factors to be considered; in the instant situation, the Examiner's view is that the teaching of the

applied reference(s) clearly suggest doing what applicants have done - compare In re Kronig 190 USPQ 425; In re Lintner, 173 USPQ 560; thus, although prior art workers may not have been faced with or been aware of applicants' problem, the teaching in the prior art provide (sufficient) motivation for doing what applicants did/have done.

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 17 is further rejected under 35 U.S.C. § 103(a) as being unpatentable over Weissgerber et al. in view of applicants' admission as to what constitutes prior art/the state of the art (hereinafter referred to as the prior art admission).

The prior art admission (N.B. page 8 lines 25-28 of applicants' specification) establishes that the drying (i.e. resin recovery) technique envisioned for use by applicants is known, such that it would have been obvious to one of ordinary skill in this art to employ such a conventional, documented resin

recovery technique in conjunction with the aqueous adhesive dispersions of Weissgerber et al., wherever deemed desirable and/or necessary, in that (a) these resin dispersions are seen to be the same as those envisioned by applicants; and (b) a mere (physical) removal of the water carrier or dispersing medium is required, with no unexpected results being obtained; mere utilization of a technique in conjunction with a known material involved.

8. Applicant's arguments with respect to claims 1-17, filed 13 March 2002, have been considered but are deemed to be moot in view of the new grounds of rejection.

9. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED

STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) ~~305-3599.~~ 872-9311

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.

JJG

JJGallagher:cdc

June 4, 2002

JOHN J. GALLAGHER
PRIMARY EXAMINER
ART UNIT 1733